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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,411	10/08/2003	Fred Sanford	12780-023001 / 02,003	4319

26171 7590 03/29/2006

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EXAMINER	
JARRETT, RYAN A	

ART UNIT	PAPER NUMBER
2125	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/680,411	SANFORD ET AL.	
	Examiner	Art Unit	
	Ryan A. Jarrett	2125	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20,22-29 and 38-46* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20,22-29 and 38-46* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-10 and 38-46 drawn to an apparatus for monitoring performance of an industrial process, classified in 700/108, 702/182, and/or 702/188, for example.

   II. Claims 11-20 and 22-29 drawn to a method of optimizing industrial production comprising, classified in 700/108, 702/182, and/or 702/188, for example.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the methods of Group II can be practiced by an apparatus that does not require a block configurator for controlling application object data generated for at least one workstation from a central location, or a remote collector that collects application object data from at least one workstation associated with process field devices, or a workstation block processor that creates application objects from

application object files controlled by a service portal processor, initializes the application objects, and defines data probes, as is required by the apparatuses of Group I.

3. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper. The inventions cut across multiple subclasses and require different text searches, and thus present a serious burden to the Examiner.

4. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions

unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Response to Arguments

6. Applicant's election with traverse of Group I, claims 1-10, in the reply filed on 3/2/06 is acknowledged. The traversal is on the ground(s) that the Office has not made any attempt to show that examination of the former Groups I-IV in the same application would present a serious burden on the Examiner. This is not found persuasive because Examiner provided this showing in section 3) of the Office Action mailed 12/30/05.

Applicant further argues that the prosecution history of the present application clearly establishes that an examination of former Groups I-IV in the same application would not present a serious burden on the Examiner since, for example, former Groups I-III were already examined by the Office in the Action mailed on 7/5/05. However, subsequent to this action mailed on 7/5/05, the Applicant amended each independent claim to contain a new, different limitation, and additionally presented a new set of claims 38-46. Applicant's amendment necessitated the restriction. The apparatus and

method were not patentably distinct before the amendment, but the nature of the Applicant's amendment made the apparatus and method patentably distinct. If Applicant would have amended the claims in kind, then there would be no restriction requirement. It doesn't matter that a former version of these claims were previously examined. If Applicant's amendments distinguish the claims over the prior art as the Applicant argues, then a new search will be required to determine if the new claims are patentable. It is possible that any art found for Group I would not contain the features of Group II, and vice-versa. This presents a serious burden for the Examiner.

Applicant further argues that there is no serious burden since the Examiner previously indicated that former groups I-III were actually classified in the same class and subclass, e.g., class 700, subclass 36. Actually, the Examiner indicated that Claims 1-29 were classified in class 700, subclass 108. Nevertheless, only one example subclass was provided for these claims since these claims were previously contained in the same group (before the amendment), and there was no need to provide any additional subclasses. These claims could potentially be classified in *several* subclasses (e.g., 702/182, 702/188). And the serious burden is based on the fact that the inventions require a different field of search, not a different classification. The classification system is only one means relied upon by Examiners for conducting searches. Text searching is increasingly becoming the main means relied upon by Examiners for conducting searches, especially for claims that cut across several subclasses.

Applicant also separately argues that Groups I and IV should be grouped together. This argument is generally found persuasive. Therefore, the restriction requirement between former Group I (claims 1-10) and former Group IV (claims 38-46) is withdrawn based on the new guidelines for restrictions based on subcombination usable together. Also, the restriction requirement between former Group II (claims 11-17) and former Group III (claims 18-20 and 22-29) is withdrawn for the same reason. Subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. Furthermore, the new guidelines dictate that the examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination. In the instant case, while the respective subcombinations contained in each of new Group I and new Group II, respectively, are not considered obvious variants, they do not appear capable of having utility in anything other than the disclosed combination, i.e., by themselves or in another combination.

The new restriction requirement now consist of only two groups, apparatus claims and method claims. Since the restriction requirement has changed, Applicant is given the opportunity to re-elect the invention of his choosing.

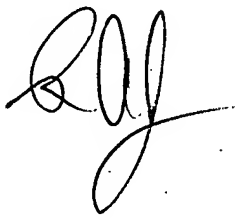
Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan A. Jarrett whose telephone number is (571) 272-3742. The examiner can normally be reached on 10:00-6:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on (571) 272-3749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ryan A. Jarrett
Examiner
Art Unit 2125



3/21/06
RAJ